

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 3 and 4 and independent claim 5 with dependent claim 8 will be present in the application.

Claim 1 has been amended to recite that the method further comprises the steps of clamping a horizontal reel on a primary arm in a vertical position above a reel drum and swivelling the primary arm around the axis of the reel drum until the horizontal reel is in a horizontal position resting on the reel drum. Claim 1 has also been amended to recite that the steps of running, winding, pressing, measuring and controlling all occur while the primary arm is being swivelled from the vertical position to the horizontal position. Such operation is disclosed on page 3, line 21, to page 4, line 27, of the specification. Claim 5 has been amended to recite that the horizontal reel and the pulp sheet wound on the horizontal reel are biased toward the reel drum by the hydraulic cylinder and integral load sensing device. Such apparatus is disclosed on page 4, lines 4-8, of the specification. Accordingly, the amendments do not introduce any new matter.

Claims 5 and 8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the Office Action alleging that the load sensing device of the primary arm is located adjacent to the horizontal reel and thus does not support the horizontal reel. Claim 5 has been amended to recite that the horizontal reel and the pulp sheet wound on the horizontal reel are biased toward the reel drum by the hydraulic cylinder and integral load sensing device. As disclosed on page 4, lines 14-19, of the specification and shown in Figure 1, the paper roll and the holding device 11 on which the paper roll is placed rest on load sensing device 16 of the secondary arm. Accordingly, the rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 5,845,868 (Klerelid). Claim 1 has been amended to recite that the method further comprises the steps of clamping a horizontal reel on a primary arm in a vertical position above a reel drum and swivelling the primary arm around the axis of the reel drum until the horizontal reel is in a horizontal position resting on the reel drum, with the steps of running, winding, pressing, measuring and controlling all occur while the primary arm is being swivelled from the vertical position to the horizontal position. The Klerelid reference clearly does not disclose such apparatus. Accordingly, the rejection of claim 1 must be withdrawn.

Claims 5 and 8 were rejected under 35 U.S.C. § 103 as being unpatentable over the Klerelid reference. The Office Action admits that Klerelid does not disclose either a load sensing device supporting a horizontal reel or a load sensing device located with

a horizontally adjustable holding device supporting the horizontal reel but cites In re Japikse, 86 USPQ 70, for the *per se* rule that “rearranging parts of an invention involves only routine skill in the art.” The Office Action admits that Klerelid does not disclose a load sensing device integrated into a hydraulic cylinder but cites Howard v. Detroit Stove Works, 150 U.S. 164 (1993) for the *per se* rule that “forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.” However, “reliance on *per se* rules of obviousness is legally incorrect and must cease. ... We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules.” In re Ochiai, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). The court in In re Ochiai further held that “The test of obviousness *vel non* is statutory. It requires that one compare the claim’s “subject matter as a whole” with the prior art “to which said subject matter pertains.” 35 U.S.C. § 103. The inquiry is thus highly fact-specific by design.” Id., at 1131. “The use of *per se* rules ... flouts section 103 and the fundamental case law applying it.” Id., at 1133. See also Ex parte Granneman, 68 USPQ2d 1219 (B. Pat. App. & Int. 2003).

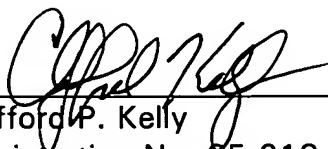
The prior art rejections of claims 5 and 8 with respect to a load sensing device supporting a horizontal reel, a load sensing device located with a horizontally adjustable holding device supporting the horizontal reel, and a load sensing device integrated into a hydraulic cylinder rely entirely on *per se* rules and do not compare the claims’ subject matter as a whole with the prior art to which the subject matter pertains. Accordingly, the Office Action does not make a *prima facie* case of obviousness and the rejection of claims 5 and 8 must be withdrawn.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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